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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,135	02/20/2004	Manoj Ajbani	DN2000-223D01	7794

7590 08/11/2004

The Goodyear Tire & Rubber Company  
Department 823  
1144 East Market Street  
Akron, OH 44316-0001

EXAMINER
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REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/783,135

Applicant(s)

AJBANI ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11, 14-16 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 12, 13 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

#### **DETAILED ACTION**

##### **Information Disclosure Statement**

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

##### **Specification**

2. The abstract of the disclosure is objected to because it houses words in excess of 150. Correction is required. See MPEP § 608.01(b).
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: As far as the Examiner can tell, proper antecedent basis for "1 phr to about 70 phr of silica" per claim 10 has not been provided.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

##### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 12, 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A) The recited "smectite", vermiculite and hallosite" per claim 12 constitutes indefinite subject matter as per there being insufficient antecedent basis for these limitations in the claim.
- B) The recited "derivatives thereof heterocyclic amine" per claim 13 constitutes indefinite subject matter as per said phrase engendering ambiguous as well as awkwardly expressed claim language. The following language is suggested: "derivatives of heterocyclic amine" so as to engender claim language clarity.
- C) The recited "selected from the group of compounds of having the structural formula" per claim 17 constitutes indefinite subject matter as per said phrase engendering improper Markush language. When materials recited in a claim are so related as to constitute a proper Markush group, they should be recited in the conventional manner, or in the alternative. For example, "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, or alternatively, "wherein R is A, B, C or D" is also proper. See M.P.E.P. § 2173.05(h).

#### Allowable Subject Matter

7. Claims 1-20 are deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the process for making a vulcanized rubber article which involves the use of an amino group containing rubbery polymer and an organophilic 2:1 layered silicate clay, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to use a layered silicate clay, as claimed, in lieu of or in addition to the clay component of Howland et al(U.S. 3,004,936) nor to swap the non-amino group-containing rubbery polymer of EP 1,029,823 for an amino group-containing rubbery polymer, as claimed with any reasonable expectation of success, Howland et al and EP'823, meritorious of the closest prior art. Moreover, any prima facie case of obviousness has been diffused based on the Tabulated data housed in the specification. Claims 1-11, 14-16 and 18-20 are allowed. Claims 12, 13 & 17 would be allowed if rewritten and/or amended so as to obviate the §112, 2<sup>nd</sup> paragraph issues raised supra.

#### Conclusion

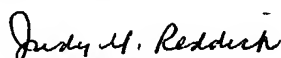
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8. The prior art to Howland et al(U.S. 3,004,936), Pinnavaia et al(U.S. 6,414,069 B1) & EP 1,029,823 A2, listed on the attached PTO FORM 892, are cited as of being illustrative of the general state of the art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
08/07/04